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09/804,909	03/13/2001	Kenneth S. Ehrman	ID-3	7706

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ISRAEL NISSENBAUM  
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EXAMINER

JASMIN, LYNDIA C

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/804,909

Applicant(s)

EHRMAN ET AL.

Examin r

Lynda Jasmin

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 27 May 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Amendment received on May 27, 2003 has been acknowledged.

#### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 27, 2003 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of new added "data collective database", "analysis means" the "timing means and sensing means to determine the store periods of time" and the "activation means."

#### ***Specification***

3. The amendment filed May 27, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: Applicant has added "referenced to fuel level analysis element 34", "embodying timing and sensing means 15" and "or data collection database 40".

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3, 9, 10 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to provide an adequate written description of the “analysis means for interpreting factors relevant to the meaning of a particular fuel level sensor readings” and “correlation means to evaluate a vehicle fuel tank as being filled...” as mentioned in claim 3. Further, the specification does not provide adequate written description of the “store maintenance information unique to the vehicle” as mentioned in claim 9. Also, the specification fails to adequately describe “timing means and sensing means to determine and store periods of time in which the vehicle is located in said lot to determine efficiency in vehicle processing” as mentioned in claim 10. Further, the specification fails to adequately describe the “activating means” as mentioned in claim 14. *No new matter will be allowed to be entered into the specification or drawing figures.*

6. Claims 3, 9, 10 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In paragraph [0038], lines 3 and 9, the added matter "reference to fuel level analysis element 34" and "embodying timing and sensing means 15" were not described in the specification as originally filed. Also, in paragraph [0040] line 17 the recitation "or data collection database 40" was not described in the originally filed specification. Same as in drawing Figures 1 and 2.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-9, and 11-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Strong (6,006148).

Strong discloses an automated vehicle rental, return and billing system as claimed where each vehicle (32), to be rented and removed from a vehicle renting lot (36), has a unique vehicle identifier (device ID 218, via field 208), with the lot having at least two of the vehicles (col. 4, lines 59-61), and wherein each vehicle is provided with transmitter/receiver means and memory storage means (264) linked thereto (col. 5, lines 20-58), with the vehicle identifier being initially stored in memory storage means (col. 7, lines 40-55). Each of the vehicles (32) further includes odometer reading sensor means (via 350) operatively linked to an odometer of the vehicle (col. 8, line 51 through

col. 9, line 19) and where each of the vehicle further has fuel sensor means (via 330) linked to a fuel level sensor of the vehicle (via 410).

The system of Strong further includes a data collection data base (via 52) and means for enabling each of the transmitter/receiver means (via 58) (col. 4, line 34-36) to communicate with the data collection data base from any location within said renting lot (when a vehicle enters the return garage or surrounding area), when the vehicle is returned to a vehicle rental lot, to transmit stored final odometer reading and fuel level to the data collection data base for remote calculation of charges and check-in of the vehicle when the vehicle is returned to the vehicle rental lot (col. 3, lines 54-64 and col. 12, lines 10-17). Each of the transmitter/receiver means is adapted to separately communicate with the database without interference with communication from another of the transmitter/receiver means within the lot (col. 4, lines 64 through col. 12, line 2; each processor have some unique identifiable address so that information could be directed to this processor without disruption to other vehicle monitoring circuits in each cell coverage area of the base station).

Strong further discloses a check out site in operative communication with the transmitter/receiver means with means at the site for printing out a rental agreement having personal identification, vehicle identification, rental options, and credit card information, (via pre rental status information) and where the check-out site has a terminal with correlative personal and vehicle identification transmitted thereto by one of data collection data base and transmitter/receiver means for user as a security check

prior to permitting the vehicle to exit the vehicle rental lot (col. 10, line 64 through col. 11, line 13).

Also, Strong further discloses the fuel sensor means (330) further includes analysis means for interpreting factors relevant to the meaning of a particular fuel level sensor readings for the vehicle under varying vehicle operating conditions, the analysis means (via processor 260) for interpreting factors relevant to the meaning of a particular fuel level sensor readings for the vehicle under varying vehicle operating conditions, has correlation means to evaluate a vehicle fuel tank as being filled when the vehicle is not moving and the fuel in the fuel tank is simultaneously rising (col. 10, lines 23-38).

Strong further discloses the transmitter/receiver means provides information of location thereof within the rental lot and information related to the vehicle to which it is attached to mapping means for tracking location and readiness of the vehicle for re-renting (col. 9, line 59 through col. 10, line 7).

Strong further discloses at least two vehicles are mapped on the mapping means for tracking location and whereby vehicle system operations can be prioritized on the vehicles as a function of vehicle location and type of vehicle and wherein a real time automated inventory of available vehicles is obtainable from the mapping means (col. 4, line 56 through col. 5, line 18). The transmitter/receiver means (282, 284) of the individual vehicles (32) are capable of communicating with each other and the database to provide the information of location (col. 8, lines 20-31).

Strong further discloses at least one of the odometer and fuel sensing means and transmitter/receiver means is interchangeable between different vehicles and

wherein the at least one of the odometer and fuel sensing means and transmitter/receiver means is programmable to adapted to be operable for the different vehicles (col. 4, lines 26-33).

Strong further discloses a personalized greeting display which is visible at or proximate to lot which displays a personalized message to a driver of the vehicle with personalized information transmitted thereto by transmitter/receiver means (col. 11, lines 20-26).

Strong further discloses storage means is adapted to store maintenance information unique to vehicle (col. 11, lines 41-55).

Strong further discloses fixed node devices (via 58) capable of communication with the transmitter/receiver means, with each other and the data collection data base are disposed with the rental lot to facilitate communication of data and position of vehicles within the lot (col. 4, lines 13-33).

Strong further discloses identification of a renter of the vehicle is associated in the memory storage means during a pre-determined rental period (col. 6, lines 51-56).

Strong further discloses the vehicle further contains data entry means for the renter to enter personal identification and desired rental options and credit card charging means and wherein the transmitter/receiver means stored the personal identification in memory storage means and transmits personal identification, desired rental options and credit card information to the data collection data base while the vehicle is in the vehicle rental lot and wherein the data collection data base and the transmitter/receiver transmits validation instructions to validate permission for removal



of the vehicle from the rental lot, and to enable activation of the vehicle with activation means the data entry means are removable and adapted to be positioned and operatively linked to transmitter/receiver means in other vehicles (col. 12, line 29 through col. 13, line 10).

Functional recitation(s) using the word “capability of” and “adapted to” as recited in claims 1, 6, 7, 9 and 15 have been given little patentable weight because they fail to add any function and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Strong (6,006,148), in view of Flick (6,507,786).

Strong discloses all the elements of the claimed invention, but fails to explicitly disclose the transmitter/receiver means further comprises timing means and sensing means to determine and store periods of time in which the vehicle is located in lot to determine efficiency in vehicle processing.

The US Patent to Flick discloses the concept of having a time with each occurrence of the vehicle remaining stationary for greater than the predetermined period via monitoring station (30) which time stamp received information.

From this teaching of Flick, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Strong include the monitoring station taught by Flick for the purpose of determining the efficiency of transaction processing for each of vehicle.

### ***Response to Arguments***

12. Applicant's arguments filed May 27, 2003 have been fully considered but they are not persuasive. The Examiner respectfully disagrees with Applicant arguments on pages 10-13.

13. Applicant first argues, on page 11, that his interpretation of the originally filed disclosure and drawings with regards to the "analysis means for interpreting factors

relevant to the meaning of particular fuel level sensor readings” and the recitations in claims 9 and 10 would be readily evident to one of ordinary skill in the art. The Examiner respectfully disagrees. It is the Examiner’s position that what may or may not be obvious is not the test. *Lockwood vs. Anderson*, 41USPQ 2d @ 1966. Applicant has the burden of showing that a person of skill in the art “would have understood, at the time the patent application was filed, that the description requires the limitation.” *Hyatt*, 47USPQ 2d @ 1131.<sup>1</sup>

14. Applicant next argues, on page 12, that Strong “specifies that only a specified area or zone is available for communication, i.e. only one vehicle in only a specific zone at a time.” The Examiner respectfully disagrees. Strong discloses that only vehicles 32 (referring to a plurality of vehicles) within a known zone of the base station 58 will receive the polling message. Strong further discloses that any suitable number of base stations 58 may be employed to carry out the present invention. Thus, Strong is clearly not restricted to only one vehicle in only a specified zone). Strong further discloses that the vehicle return zone includes any region in which the vehicle can wirelessly transmit information to a device.

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<sup>1</sup> i. “The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought.” *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

ii. “Although the exact terms need not be used in haec verba, the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.” *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

iii. “Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.” *In re Huston*, 308 F.3d 1267, 1277, 64 USPQ2d 1801, 1807 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997).

Applicant further argues that in the Strong reference, "there is not the slightest teaching or suggestion of a lot having at least two vehicle wherein communication is effected throughout the lot." The Examiner again respectfully disagrees. The Examiner also notes Strong (col. 5, lines 60-64) discloses that the RF section includes antenna for receiving radio signals from and transmitting radio signals to vehicles and buses within the cell coverage area of the base station, and Strong also discloses that there may be any suitable number of base stations within the lot, and each base status defines a zone of coverage in which successful wireless communication may occur.

15. Applicant's arguments having been found unpersuasive, the rejection has not been withdrawn.

### ***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

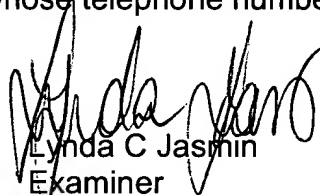
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda C Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1113.

  
Lynda C Jasmin  
Examiner  
Art Unit 3627

lj  
July 17, 2003

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